

No. _____

IN THE
Supreme Court of the United States

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JENNIE NICASSIO,

Petitioner,

v.

VIACOM INTERNATIONAL, INC., AND
PENGUIN RANDOM HOUSE, LLC,

Respondents.

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**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Third Circuit**

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PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Under the idea/expression dichotomy, the Circuits agree that in comparing original to allegedly copied works to determine *actual copying*, (a) elements of a generic plot, (b) general themes, and (c) under the *scènes-à-faire* doctrine, plot elements that are *commonly* used in, or *necessary* for, the treatment of generic plots and general themes should not be considered. The first question is:

Whether the *scènes-à-faire* evidence exclusion for actual copying should extend to *all* plot elements *naturally flowing* from a *simple formulation* of the plot of the original work?

2. Copyright infringement requires actual copying and wrongful appropriation. The Circuits agree that material not original to the author should not be considered in the comparison assessing wrongful appropriation. However, respecting the *original expression* of the author, the Circuits have created two diametrically opposed rules. The second question is:

Whether the proper test to determine wrongful appropriation is (a) comparing the original work *as a whole* to the copied portions in the allegedly infringing work, or (b) assessing fairness only after (i) removing and disregarding original elements deemed to be *scènes-à-faire*, and (ii) putting material added by the alleged infringer into the comparison?

RULE 14.1 (b) AND 29.6 STATEMENTS

Pursuant to Supreme Court Rule 14.1 (b), petitioner Jennie Nicassio (“Nicassio”) states that all parties to the proceedings below appear in the caption of the case on the cover page.

Pursuant to Supreme Court Rule 29.6, Petitioner states that no publicly traded company owns 10 percent or more of Nicassio, and that Nicassio is a natural person.

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OPINIONS BELOW

United States Court of Appeals for the Third Circuit's opinion, App. 1a, is not reported but is available at https://scholar.google.com/scholar_case?case=18364838672437750239&q=nicassio+copyright&hl=en&as_sdt=8006. The United States District Court for the Western District of Pennsylvania's opinion, App. 15a, is reported at 309 F.Supp.3d 381.

JURISDICTION

The District Court had federal question jurisdiction under 28 USC §1331, and the Court of Appeals had jurisdiction under 28 USC §1291. The Court of Appeals filed its opinion on July 7, 2019, and review of this opinion is sought. On July 15, 2019, Petitioner timely filed a petition for rehearing and rehearing en banc. The Third Circuit denied the petition on July 31, 2019. This Court's jurisdiction rests on 28 USC §1254 (1).

STATUTORY PROVISIONS INVOLVED

Section 106 of the Copyright Act of 1976, 17 USC §106, states, in pertinent part:

§ 106 · Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies...;

* * *

(4) in the case of literary... works... to perform the copyrighted work publicly;

* * *

Section 501 of the Copyright Act of 1976, 17 USC §501, states, in pertinent part:

§ 501 · Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 or of the author as provided in section 106A(a), or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright or right of the author, as the case may be.



STATEMENT

This Petition centers on diametrically opposed rules in the Circuits respecting the most basic question in copyright law, namely, when does copying of a copyrighted work go beyond a fair taking of ideas (whose dissemination the law is meant to

promote) and into the wrongful appropriation of copyrightable expression. Moreover, the nature of the circuit split is outcome determinative in all but the few cases where infringement has been literal and ubiquitous. Thus, resolution of the questions presented is of substantial importance.

The confusion which gave rise to the circuit split continues. It illustrates itself in numerous recent decisions lumping together, often under the rubric of “unprotectable elements,” numerous fundamentally different types of content (the admissibility of which is different in different circuits). These include subject matter copied by an author from another source, historical facts, *scènes-à-faire* (defined differently in different Circuits) and simple, but original, copyrightable expression, as well as the universal elements of stories in a generic category. Likely, the confusion results, in part, from conflating the “similarity” comparisons of the first and second elements of copyright infringement, something cautioned against by the Second Circuit. Also apparently involved is a prejudice toward the lay meaning of the word “idea” which can be used to describe the most creative expression, thought this approach violates the injunction of this Court in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991) to protect even very simple original expression.



The present case relates to the copying of a children’s book authored by Petitioner, Jennie

Nicassio. Its theme is teaching children to set lofty goals and persevere in pursuing them. The importance of this aspect of teaching underscores the importance of the incentives and protections afforded by Article 1, Section 8 of the U.S. Constitution, which is to encourage authors to make the important effort of creating such works and devote the resources needed to promote their distribution.

Respect for the Constitutional objective of protecting and incentivizing authors is vital to the progress of our nation. Without those incentives, many individuals will be dissuaded from risking the effort of making their contribution, whether they are high ranking individuals with many responsibilities and perhaps much to teach, or promising young minds facing the daunting task of making a place for themselves in the world and having to judiciously choose where to put their efforts.

The facts of the present case illustrate dramatically how the Ninth Circuit rule, also followed in the Third and Sixth Circuits, undercuts the implementation of these important Constitutional objectives as enacted by Congress.

Ms. Nicassio's work falls squarely within the Constitutional mandate of promoting the dissemination of knowledge, in this case teaching children core societal values including aspiration and effort in the context of respect for others. While her book most likely would have been protected in most of the Circuits, in the Third, Sixth and Ninth Circuits, it could not survive a motion to dismiss.

The book at issue in this Petition, titled “Rocky” and published in several different versions, tells the story of a little evergreen tree named Rocky who dreams of becoming the Rockefeller Center Christmas tree and embarks on an adventure toward that goal, facing mockery and physical attack in his community of anthropomorphic and human characters, fighting discouragement with the help of a fairy mentor and finally becoming the “most famous Christmas tree in the world.” The accused book and movie “Albert” share the same story and copy all of these plot elements and more (App. 32a-34a). Copying was conceded for purposes of the subject motion.

While the copied work, “Albert,” makes a few additions to the story (irrelevant to whether there has been an appropriation and, under the Majority rule, irrelevant to whether the appropriation was fair), the central plot remains the same. The heart of the story is the same: a small imperfect evergreen tree seeking the impossible dream of becoming the Rockefeller Center Christmas tree, and militating against adversity in the face of seeming impossibility. In addition, patches of linguistic expression at the heart of the original, and constituting some of the highlights of the story were lifted by the copyist. These both evidence the conceded copying and are part of a substantial body of evidence strongly supporting a finding of wrongfulness.

Nevertheless, the infringement claim was dismissed by the Third Circuit under the Ninth Circuit rule for determining copyright infringement. Under that rule, 1) plot elements known as *scènes-à-faire*, which receive limited evidentiary application, are defined to include not only a) plot elements which are necessary to a generic category of stories, but also (more expansively than in the other Circuits) b) all plot elements which merely “*naturally flow*” from a *simplified version* of the original plot.

In addition, and contrary to the longstanding majority rule against dissection, 2) all those elements, though they are original expression of the author and may lie at the heart of the story, are removed from the original and the copied work before the works are compared. This leaves only peripheral plot elements to determine whether the copied story satisfies the second element of copyright infringement, namely wrongful appropriation in the view of a lay reader. The resulting Ninth Circuit comparison of the two incomplete phantom works to determine the impact of the two whole works on an ordinary reader has been criticized as mechanical and counterintuitive.

In the majority of the Circuits, the opposite outcome would have occurred. Petitioner would have been given the opportunity to have the fairness, *vel non*, of the appropriation assessed in a holistic comparison of the works by a jury of her peers.

District Court Proceedings

The District Court had federal question jurisdiction under the Copyright Act of 1976. The first element of infringement, copying, was conceded for purposes of the subject motion under Rule 12. The questions presented in this Petition were raised in a motion to dismiss filed by the Defendants.

The District Court found the overall plot of a little evergreen tree with the “dream” of becoming the Rockefeller Center Christmas tree “too generic” to merit protection. The District Court characterized a large portion of the admittedly copied original expression as “unprotectable” *scènes-à-faire*, including, *inter alia*, a community of anthropomorphic and human characters, physical imperfection of the little tree, the tree facing mockery, encouraging words from a mentor (a fairy in “Rocky,” a little girl in “Albert”), physical attack on the mentor by the antagonist using plant parts (a snare of twigs in “Rocky,” cactus needles in “Albert”), a contest with judges and red bubble helicopters, and finally becoming the “most famous Christmas tree in the world,” while recalling the mentor’s encouraging words *verbatim*. Notably, the order of these elements was virtually identical in both works.

Such characterization was based upon the Ninth Circuit rule that all original expression naturally flowing from what the District Court characterized as a “too generic” plot were *scènes-à-faire*. Next, following the second aspect of the Ninth Circuit rule, the overall plot and all those elements were removed from the comparison, leaving a comparison of

disjointed peripheral plot artifacts to be compared in order to assess their impact on an ordinary reader of the work.

Moreover, when the Court compared the remaining portions of the works, improperly according to the majority rule, it factored content added in “Albert” into the comparison, finding the residue of “protectable” elements of “Rocky” different from the remaining elements from “Albert.” Defying common sense (but following its previous adoption of the Ninth Circuit rule), it found the works not substantially similar, noting that “Albert” had an additional attack from the plant rival, another attack from vegetarian bunnies, Albert’s travelling as a hitchhiker (Rocky was the intended passenger in “Rocky”), Albert’s being crowned as the top tree portion supported by the bottom portion of another tree, and then after being crowned giving his rival the chance to share the spotlight. App. 37a.

Third Circuit Proceedings

Applying the Ninth Circuit rule, the District Court’s treatment of the issues was found “proper” and was affirmed by a panel consisting of Judges Hardiman, Scirica, and Cowen. App. 8a.

Rehearing *en banc* was denied, but Judge Scirica’s and Judge Cowen’s votes were limited to denying rehearing before the original panel, suggesting that those Judges were open to having the alignment of the Third Circuit with the Ninth Circuit reconsidered.

REASONS FOR GRANTING THE PETITION

I. There is a fundamental conflict between the Circuits on the appropriate test to apply when determining copyright infringement.

To be clear, and to strike at the likely genesis of the current split in authority, the Circuits agree that some content (such as the elements of generic plots, *i.e.* elements necessary to expression of general themes and the like) is excluded in the factual determination of *actual* copying, the first element of copyright infringement.

However, under the majority view, after copying has been found, in the determination of the second wrongful appropriation element, the original and copied works are then compared *as a whole* (*i.e.* including the elements excluded from the determination of actual copying).

In contrast, under the Ninth Circuit rule, those elements are *again* removed from the original and copied works for the wrongful appropriation comparison. The Second Circuit has criticized such dissection as “mechanical and counterintuitive.” *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F. 3d 996, 1003 (2nd Cir. 1995).

The result is a radically different comparison which cuts decidedly in favor of the copiest, in this case a major studio and one of the largest publishers in the United States.

Novelty and non-obviousness is not the standard for copyright protection.

The Ninth Circuit approach makes no sense because, in effect, it removes the heart of the author's original expression (the basic structure of the work and the plot elements intimately connected to it) from the wrongful appropriation comparison, leaving an unstructured collection of random elements as a supposed basis for determining the fairness question which lies at the heart of copyright infringement cases. The approach neglects the basic tenet of copyright law that *originality* of the work is the standard, and that the *novelty and obviousness* standards, and the concomitant consideration of individual elements as in patent law have no application in copyright cases.

The result in this case, where a remarkably original plot was denied protection, illustrates the inferiority of the Ninth Circuit approach.

Just as seriously, the Ninth Circuit rule exacerbates the problems of its counterintuitive comparison of peripheral elements of the works with a liberal rule for exclusion of elements. Under this rule, it extends the exclusion (which is improper under the majority rule) beyond elements necessary to expression of a generic plot to all elements that *naturally flow* from a *simplified formulation* of the plotline. The result is a test that heavily favors movie producers in copyright cases, and frustrates

the Congressional goal of protecting the original expression of authors.

The bright line rule mandating dissection conflicts with the uniformly accepted standard of assessment of fairness in the view of the ordinary reader of the work.

It is important to keep in mind that supposed rules respecting inclusions and exclusions should not be allowed to obscure the overarching consideration that fairness is the standard, and wrongful appropriation is a question of fact to be judged by the jury based on the evidence and an assessment of fairness in the view of the ordinary reader. Thus, the bright line rule driven Ninth Circuit approach of rigidly and broadly defining *scènes-à-faire* and removing those elements and the general plotline from consideration prevents the finder of fact from deciding what weight to apply to those elements in determining whether the copied work infringes upon original expression.

Determination of *scènes-à-faire* and fairness of the taking are questions of fact that are best resolved as part of the holistic consideration of the original and copied works.

Both of the questions presented in this Petition are intertwined and concern the central question in a copyright infringement action, namely whether the taking of the original work by the copyist goes beyond a fair taking and is an infringement of the copyright. The widely followed Second Circuit rule mandates comparison by the finder of fact of the original expression of the copyrighted work as a whole to the alleged infringement. However, the Ninth Circuit rule mandates that the finder of fact “filter out and disregard” much of the author’s original copyrighted expression, including commonly used elements, generic plot elements and, most expansively, all elements that naturally flow from a simple plot formulation. *Funky Films, Inc. v. Time Warner Entertainment Co.* 462 F. 3d 1072, 1077 (9th Cir. 2006).

Under the Ninth Circuit rule the outcome in most copyright cases is opposite that under the traditional rule.

Thus, under the Ninth Circuit rule, the result on summary judgement in the vast majority of copyright lawsuits involving literary works is likely to be the opposite of the outcome under the Second Circuit rule.

A. The Test for Copyright Infringement The Copyright Act and “ideas.”

The Copyright Act differentiates between what this Court stated to be “those aspects of [a] work — termed ‘expression’ — that display the stamp of the author's originality” and which are protected against infringement (*Harper & Row, Publishers Inc. v. Nation Enterprises*, 471 US 539, 547 (1985)), and ideas and other elements subject to less, if any, protection, such as historical facts and the elements of a generic plot.

Originality is the standard.

While copyright infringement requires proof of actual copying and that the appropriation was wrongful, there is no novelty or non-obviousness requirement as in patent law. Rather, the standard is originality, and original expression of old ideas and themes is protected against copying, even if such expression is close to that of preexisting works. *See Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F. 2d 49, 53-54 (2nd Cir.).

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The historical evolution of the now conflicting tests for determining copyright infringement is indispensable to understanding the current conflict between the Circuits.

Article 1, Section 8 of the United States Constitution underlies the Copyright Act. It gives

Congress power to promote the progress of science by granting authors a time-limited exclusive right to their works of authorship. Following from the words of the constitutional grant of power there has been a longstanding recognition in our jurisprudence that copyright law cannot constitutionally make a grant at cross-purposes with the constitutional objective of promoting the progress of science and the useful arts. This recognition manifests itself in numerous judicial decisions which state that while “expression” may be protected under the copyright law, the copyright law does not extend to the protection of the underlying “ideas” and the technology or “art” they describe.

The decisions dealing with the idea/expression dichotomy all flow from this Court’s decision in *Baker v. Selden*, 101 U.S. 99 (1880). However, *Baker* involved a technological idea which was fundamentally different from a literary plot as is at issue in this Petition. More particularly, *Baker* involved the question of whether to “give to the author of [a] book an exclusive property in the art described therein.” *Baker* at 102. However, such “art” was found by this Court to be within “the province of letters-patent, not of copyright.” *Baker* at 102. In that case, Selden had invented an accounting system which had the advantage of a simplified presentation of accounting data on ledger forms. Selden published a book describing his accounting system and included within the book forms designed to implement his accounting system. After Selden

published, Baker began to sell accounting forms for implementing Selden's system.

In its reasoning, this Court viewed Selden's work as akin to a book on a technological art.

“The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds... so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book.” *Baker* at 103.

In *Baker*, this Court rejected the Complainant's “conten[tion] that... no one can make or use... ruled lines and headings made and arranged on substantially the same system, without violating the copyright.” *Baker* at 101. Rather, “[t]he description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright.” *Baker* at 105. *Baker* thus draws a line between literary expression which is protected by copyright, and technological ideas which are within the purview of patent law.

Because they are fundamentally different, ideas for application in the useful arts, writings about such ideas, and literary ideas are treated differently under the law.

In *Baker v. Selden*, this Court found the system invented by Selden to be a useful “art” within the purview of the patent law. Conversely, it stated that the “introductory essay explaining the system” was eligible for copyright protection.

However, and most importantly, literary “ideas,” were not explicitly addressed in *Baker*, and are fundamentally different from the uncopyrightable technological idea at issue in *Baker*. Rather, literary ideas, such as those at issue in this case, *involve no technological “art”*.

The cases came closer to addressing the present issue about twenty years after *Baker*, in *Holmes v. Hurst*, 174 U. S. 82, 86 (1899), where, in the context of a literary work, this Court stated that “[t]he right thus secured by the copyright act is... the right... to that arrangement of words which the author has selected to express his ideas.”

Fairness is the standard in the determination of copyright infringement.

The leading case dealing with the idea/expression dichotomy in the literary context, *Nichols v. Universal Pictures Corp.*, 45 F. 2d 119 (2nd Cir. 1930) relies on this Court’s decision in *Holmes* in refining the distinction between idea and expression.

In *Nichols*, Judge Learned Hand reasoned that a “series of abstractions” approach could be used to define the line between idea and expression.

“Upon any work... a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas,’ to which, apart from their expression, his property is never extended.” *Nichols* at 121.

The location of that “point,” the interface where expression becomes idea, is determinative of the fairness-based assessment of the factual question of “wrongful appropriation.”¹ The finder of fact must determine the position of that point, and as expressed in *Nichols*,

“the question is whether the part so taken is ‘substantial,’ and therefore not a ‘fair use’ of the copyrighted work; it is the same question as

¹“Wrongful appropriation,” at the risk of confusing the different but similarity-based proofs of the two elements of copyright infringement, is sometimes referred to as “substantial similarity.”

arises in the case of any other copyrighted work.”
Nichols at 121.

The fairness standard pervades the assessment of copyright infringement in multiple contexts.

The above fairness standard of *Nichols* has been applied by the courts both in the context of determining the wrongfulness of the appropriation on the question of infringement, as well as in the defensive context through the doctrine of fair use, now codified in 17 U.S.C. §107 of the Copyright Act. That standard for this question of fact was illustrated by Judge Hand:

“If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, *or* a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's ‘ideas’ in the play.” *Nichols* at 121. (emphasis added.)

The fairness standard has been held not to require literal copying.

In *Sheldon*, Judge Hand stated the test for infringement as comprising:

“two questions: First, whether the defendants actually used the play; second, if so, whether theirs was a ‘fair use.’” *Sheldon* at 54.

Moreover, he stated:

“a play may be pirated without using the dialogue.” *Sheldon* at 55.

Rather, a work

“may often be most effectively pirated by leaving out the speech, for which a substitute can be found, which keeps the whole dramatic meaning.” *Sheldon* at 56.

Fairness mandates that adding material will not cure infringement where the appropriation was wrongful as stated in *Harper*, putting the Ninth Circuit rule at odds with this Court.

In *Harper*, this Court addressed the fairness issue in the defensive context in its assessment of the “amount and substantiality of the portion used” as a factor in the fair use defense. “As the [fair use] statutory language indicates, a taking may not be excused merely because it is insubstantial with respect to the infringing work.” In so holding, *Harper* endorsed the Second Circuit rule respecting the irrelevance of the addition of material to an infringing work.

“As Judge Learned Hand cogently remarked, ‘no plagiarist can excuse the wrong by showing how much of his work he did not pirate.’ [citing *Sheldon*]” *Harper* at 565.

Accordingly, the Third Circuit acted contrary to the direction of this Court in considering plot elements added by the alleged infringer.

In *Arnstein v. Porter*, 154 F. 2d 464, 469 (2nd Cir. 1946), the Second Circuit reiterated its two question rule from *Sheldon*. “[I]t is important to avoid confusing two separate elements essential to a plaintiff’s case in such a suit: (a) that defendant copied from plaintiff’s copyrighted work and (b) that the copying (assuming it to be proved) went so far as to constitute improper appropriation.” In *Arnstein*, the court unequivocally stated: “Each of these two issues — copying and improper appropriation — is an issue of fact.”

The first element, copying, is a question of fact and dissection is relevant to proving copying.

Copying may be proven by evidence which “may consist (a) of defendant’s admission that he copied or (b) of circumstantial evidence — usually evidence of access — ... and similarities... [from which] the trier of the facts must determine whether the similarities are sufficient to prove copying.” *Arnstein* at 468. “[T]o prove copying..., analysis (“dissection”) is relevant, and the testimony of experts may be received to aid the trier of the facts.” *Arnstein* at 468.

All the Circuits follow this view, which may be justified on the basis that when the finder of fact is determining actual copying, similarities in plot elements that are common to a generic category, such as mysteries, or associated with a common

theme, or are necessary, may be explainable as having been introduced into an allegedly infringing work as a result of something other than copying. Of course, once copying is established, following the majority rule, the thus proven copied elements are to be compared in their totality to the original, and the fairness of the appropriation determined by considering and weighing all of the evidence, perhaps giving less weight to *scènes-à-faire*. *Johnson v. Gordon*, 409 F. 3d 12, 19 (1st Cir. 2005).

In determining the second element, wrongful appropriation, the Second Circuit has unequivocally rejected dissection in favor of a fully informed fairness determination.

Arnstein clearly states the majority rule that, in making the wrongful appropriation determination, the original expression of the original must be compared to the copied work, and that comparison must be of the works as a whole, and not of dissected versions. Such comparison makes sense, as the finder of fact can see all similarities, judge their importance under the law and make a fully informed fairness determination.

In particular, the Second Circuit states that as to “the second issue, that of illicit copying (unlawful appropriation)[,]... the test is the response of the ordinary lay hearer; accordingly, on that issue, ‘dissection’ and expert testimony are irrelevant.” (Parenthetical material in the original) *Arnstein* at 468.

Arnstein also affirms the fairness standard of *Nichols* in the determination of the wrongful appropriation question. “[The] question, therefore, is whether defendant took from plaintiff’s works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.” *Arnstein* at 473. [Emphasis added.]

More recently, in *Knitwaves*, the Second Circuit reiterated its rule that a court should “examine the works’ ‘total concept and feel” in making the wrongful appropriation determination. In *Knitwaves*, the Second Circuit again rejected dissection of *scènes-à-faire* from the wrongful appropriation comparison despite Lollytogs’ urging that the District Court, “[i]nstead of comparing the sweater designs as a whole... should have ‘extracted the unprotectible elements’ — namely, the use of common stripes and colors — and compared only the sweaters’ distinctive elements.” In again rejecting dissection, the Second Circuit harshly criticized dissection as “mechanical and counterintuitive.” *Knitwaves* at 1003.

In a copyrighted work, there is a fundamental distinction between uncopyrightable material not created by the author, and aspects of the original work created by the author, but which might be weighted differently as determined by the finder of fact in the fairness assessment of the wrongful taking determination.

Not to make too fine a point, in *Knitwaves*, the Second Circuit noted that in *Folio Impressions, Inc. v. Byer California*, 937 F. 2d 759, 765 (2nd Cir. 1991), the Second Circuit did approve filtering out an uncopyrightable element in determining similarity under the second wrongful appropriation element of copyright infringement. This uncopyrightable element, an intricate public domain pattern, was copied and used by the copyright holder as a background and incorporated into his work, as was done by the alleged copyist. *Folio* at 763. The procedure in *Folio* was thus based on identifying the actual work originated by the copyright holder (a rose design which was separate and apart from the copied background), and using the part of the work originated by the author to assess fairness.

However, there is no such preexisting work at issue in the questions presented. In this respect, such pre-existing work is not an element original to the copyright holder, and, thus, something to which the copyright never extended. Rather, such content, not having been originated by the copyright holder, is “uncopyrighted material,” and “must be

disregarded in evaluating whether the second author's use was fair or infringing.” *Harper* at 544.

Finally, while there is some general language in *Williams v. Crichton*, 84 F. 3d 581, 588 (2nd Cir. 1996) respecting whether protectable elements, standing alone, are substantially similar, in that case the two stories at issue were very different. One was a horror picture and the other a children’s book aimed at educating children about dinosaurs and depicting a safe dinosaur zoo. The language appears to be just another an artifact of the confusion and conflict between the law in the different Circuits.

The Second Circuit rule respecting the inappropriateness of dissection in determining wrongful appropriation is followed by a majority of the Circuits.

The essence of the majority rule of fairness and holistic comparison of the alleged copy to all original elements in the copyrighted work is most aptly summarized by the First Circuit:

“To the extent that the copyrighted work and the allegedly infringing work exhibit probative similarities from which actual copying might be inferred, the ensuing analysis must address the question of substantial similarity (and, thus, determine whether wrongful appropriation occurred). While a finding of substantial similarity *vel non* derives from an examination of the juxtaposed works as a whole, that examination must focus on ‘what aspects of the

plaintiff's work are protectible under copyright laws and whether whatever copying took place appropriated those [protected] elements.' *Matthews v. Freedman*, 157 F.3d 25, 27 (1st Cir.1998). After all, '[t]he mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright....' *Feist*, 499 U.S. at 348.'" *Johnson* at 19 (bracketed material in original).

See also *Harney v. Sony Pictures Television, Inc.*, 704 F. 3d 173, 180 (1st Cir. 2013):

"[T]he court 'should take pains not to focus too intently on particular unprotected elements at the expense of a work's overall protected expression.' *Coquico*, 562 F.3d at 68; see also *CMM Cable Rep, Inc. v. Ocean Coast Props., Inc.*, 97 F.3d 1504, 1515 (1st Cir.1996) (recognizing 'the potential `danger ... that courts ... will so `dissect' the work as to classify all its elements as unprotectable ... [thereby possibly] blind[ing it] to the expressiveness of their ensemble'" (alterations in original) (quoting Jane C. Ginsburg, *Four Reasons and a Paradox: The Manifest Superiority of Copyright over Sui Generis Protection of Computer Software*, 94 Colum. L.Rev. 2259, 2561 (1994)))."

In the Fourth Circuit, the standard is the "total concept and feel," and this is refined by a requirement that original and allegedly infringing works must share substantially similar ideas and

expression. See *Dawson v. Hinshaw Music Inc.*, 905 F. 2d 731, 733 (4th Cir. 1990). The Fifth Circuit requires that the works be “compared as a whole” to determine “whether a layman would view the two works as ‘substantially similar.’” *Peel & Co. v. Rug Mkt.*, 238 F.3d 391, 397, 395. In the Seventh Circuit, the rule is to judge wrongfulness in the eyes of “an ‘ordinary observer’ comparing the[] two expressions.” *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 506, 509 (7th Cir. 1994). Likewise, the Eighth Circuit rejects filtering elements of expression prior to determining the wrongfulness of the appropriation. See *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 966 (8th Cir. 2005):

“[I]t is improper to perform analytic dissection, or ‘filtering,’ when conducting the ‘intrinsic’ step. ... [T]he district court correctly asked whether the ordinary, reasonable observer would find the works, taken as a whole, to be substantially similar. See *Hartman*, 833 F.2d at 120 (stating ‘similarity of expression is evaluated using an intrinsic test depending on the response of the ordinary, reasonable person to the forms of expression’); see also *Taylor I*, 315 F.3d at 1043.”

In the Eleventh Circuit, apparently the rule is for the fairness determination of the question of wrongful appropriation to be measured by using Judge Hand’s series of abstractions analysis of the works as a whole. *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266, 14 Fla. L. Weekly Fed. C 1391 (11th Cir. 2001).

The Second Circuit cautioned against confusing the copying and wrongful appropriation elements of infringement.

Both elements of copyright infringement, copying and wrongful appropriation, thus involve a similarity assessment, making particularly *à propos* the Second Circuit's caution in *Arnstein* that "it is important to avoid confusing [the] two separate elements... (a) that defendant copied... and (b) that the copying... went so far as to constitute improper appropriation." *Arnstein* at 469. Given the tendency toward confusion between the two elements of copyright infringement, *Arnstein's*, wrongful appropriation denomination (*Arnstein* at 473), is predominantly used herein for the second element of copyright infringement, unless the context requires otherwise.

The Ninth Circuit has mandated the dissection and removal of copyrighted material created by the author before determining wrongful appropriation on the basis of what is left, putting it into direct conflict with the explicit rule in the Second Circuit, and this Court's guidance in *Harper* that the law protects "those aspects of [a] work — termed 'expression' — that display the stamp of the author's originality."

The Ninth Circuit has ignored the Second Circuit approach, which limits dissection to the first element of copyright infringement, proof of actual copying. According to the Ninth Circuit, "when applying the extrinsic test, a court must filter out and disregard

the non-protectible elements in making its substantial similarity determination.” *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir.2002). This rule is reflected in the subject Third Circuit decision and has also, apparently, been followed in the Sixth Circuit. *Kohus v. Mariol*, 328 F.3d 848 (2003).

Introducing dissection into the second element, the wrongful appropriation determination, is to make the required determination of fairness from the standpoint of the ordinary reader without even basing it on a comparison of the original and copied work seen by those readers. Rather, the rule implements comparison of two phantom works which are constructed by the court, as opposed to the works seen by readers. The Ninth Circuit’s dissection thus also directly conflicts with *Arnstein’s* “ordinary” reader test. *Arnstein* at 468.

B. The *Scènes-à-Faire* Doctrine.

Courts have held certain elements of expression as not being apt to the determination of *actual* copying.

As noted in the first question presented, the Circuits agree that historical facts, generic plots, general themes and *scènes-à-faire* enjoy only limited application in the determination of copyright infringement. While *scènes-à-faire* are admissible in the majority of the Circuits in the inquiry respecting the wrongfulness of the appropriation of the original expression, they are not used to determine actual copying in any of the Circuits.

More particularly, the second question presented is whether it is proper to define *scènes-à-faire* to extend to all plot elements which naturally flow from a simple formulation of the plot of the original work. Such a definition is more expansive than that in the majority of the Circuits, where *scènes-à-faire* are limited to elements that are necessary to and common in the generic category.

Whether or not *scènes-à-faire* are dissected out of the wrongful appropriation inquiry, the question is still of importance, because in all Circuits *scènes-à-faire* are excluded in the determination of actual copying.

***Scènes à faire* are defined by most of the Circuits as elements which are necessary, indispensable or standard in the treatment of a common theme or generic plot.**

In the Second Circuit, *scènes-à-faire* are defined variously as “sequences of events which necessarily follow from a common theme” (*Reyher v. Children's Television Workshop*, 533 F. 2d 87 (2nd Cir. 1976)), plot elements “indispensable, or at least standard, in the treatment of a given topic” (*Zalewski v. Cicero Builder Dev., Inc.*, 754 F. 3d 95 (2nd Cir. 2014)) and “stock’ themes commonly linked to a particular genre” (*Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir.1986)).

Again, the Second Circuit approach is widely followed throughout the Circuits: *Coquico, Inc. v. Rodriguez-Miranda*, 562 F.3d 62, 68 (1st Cir. 2009)

(for all practical purposes indispensable, or at least customary), following *Invs., Inc. v. Novelty, Inc.*, 482 F.3d 910, 915 (7th Cir. 2007); *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1344 (5th Cir. 1994) (“expressions that are standard, stock or common”); *Stromback v. New Line Cinema*, 384 F.3d 283 (6th Cir. 2004) (“incidents, characters or settings which are as a practical matter indispensable, or at least standard”), see also *Incredible Technologies, Inc. v. Virtual Technologies, Inc.*, 400 F.3d 1007, 1011-12 (7th Cir. 2005), *Taylor Corp. v. Four Seasons Greetings, LLC*, 315 F.3d 1039, 1042 (8th Cir. 2003) and *Atari, Incorporated v. North American Philips Consumer Electronics Corp.*, 672 F.2d 607, 616 (7th Cir. 1982); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1374 (10th Cir. 1997) (“standard, stock, or common to a topic, or if they necessarily follow from a common theme or setting”); *Peter Letterese & Associates v. World Institute of Scientology Enterprises*, 533 F.3d 1287, 1302 (11th Cir. 2008) (necessarily follow, indispensable or standard).

II. The petition should be granted to resolve the multi-circuit conflict and confusion regarding the appropriate test to apply for copyright infringement.

The Ninth Circuit has exacerbated its introduction of dissection into the fairness determination by expanding the definition of elements enjoying limited application beyond the necessary and standard, to all things which naturally flow from the elements of a generic plotline.

As noted above, the Ninth Circuit's extraction of elements of the author's original expression from the fairness comparison stacks the deck strongly in favor of the motion picture producer. The rule is broad and unyielding. According to the Ninth Circuit,

“*scènes-à-faire*, [plot elements] which flow naturally from generic plot-lines, are not protectable. ... We ‘must take care to inquire only whether **‘the protectable elements, standing alone,** are substantially similar.’” *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir.2002) (quoting *Williams*, 84 F.3d at 588 (emphasis in original)). In so doing, we ‘filter out and disregard the non-protectable elements in making [our] substantial similarity determination.’” *Funky* at 1077 [bracketed material added].

See also *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990).

The Third Circuit follows this view in its espousal of an “*imperative* to filter out unprotectable elements.” [Emphasis added.] App. 10a.

The counterintuitive nature of the Ninth Circuit wrongful appropriation assessment is further exacerbated by considering, in the comparison, plot elements added by the alleged infringer to the copied work.

If this were not enough, the Court of Appeals further degraded the integrity of the comparison of the original and infringing work by considering plot elements added in the alleged infringement in the fairness-based wrongful appropriation assessment. App 11a-12a. This directly goes against the Second Circuit rule in *Sheldon* and the law of this Court. See, *Harper* at 565, quoting *Sheldon* with approval.

The Ninth Circuit approach appears to go back over thirty years. See *Aliotti v. R. Dakin & Co.*, 831 F. 2d 898, 901 (9th Cir. 1987), where it was stated that “dissection of *dissimilarities* is inappropriate because it distracts a reasonable observer from a comparison of the total concept and feel of the works.” (emphasis added.)

In any case, the effect of the Ninth Circuit rule is at cross-purposes with the objective of protecting original expression. Quite simply, the elemental question is whether there has been a wrongful appropriation. If a wrongful appropriation has occurred, adding material will not change the fact that substantial material has been taken and will

not remedy the infringement. By considering added subject matter, the overall assessment of the evidence is unfairly clouded with irrelevant material.

The rule proposed by the Ninth Circuit conflicts with Second Circuit law in at least two ways.

The use of the term “non-protectable elements” in *Funky* is worth noting. While it sounds, at first blush, to be the same as “uncopyrightable,” it is less precise. Rather, it is a logical slide from the terminology of the earlier cases (*e.g.* “uncopyrightable” historical fact of murder of policemen in South Bronx (*Walker* at 50)). The context of the decisions in *Cavalier* and *Funky* reveals that the term “non-protectable elements” actually extends even to copyrighted subject matter originated by the author and taken by the copyist, including, and remarkably so, every aspect of the plot that naturally flows from a generic plotline. *See Cavalier* at 822 and *Nicassio* at App. 24a.

As such, it is inconsistent with the over seventy years of earlier case law detailed above, both in its broadened definition of *scènes-à-faire*, and its improper excision of that enlarged collection of plot elements from the wrongful appropriation comparison. Adding the consideration of added material to the mix pushes the rule away from a commonsense assessment of the fairness of the taking by a third increment.

The effect on the rights of authors is devastating.

The Third Circuit’s definition of a “generic” plot runs afoul of *Feist*.

What constitutes *scènes-à-faire* in the Third Circuit is broadened by its definition of the line between idea and expression as being a function of whether a formulation of the plotline of the work at issue is “too generic” without reference to the fairness question. According to the District Court, as affirmed by the Third Circuit, “the basic plot idea of a little tree aspiring to be the Rockefeller Christmas Tree in New York is... far too generic to be considered protectable under copyright law. [*Tanikumi v. Walt Disney Co.*, 616 F. App’x 515, 521 (3d Cir. 2015)]” (generic plot and theme ideas are not protectable).” App 3a.

Given the context, it is clear that the term “generic” plot is being used, not to designate a plot common to a generic category of stories, but rather to mean “simple.” In addition to the other frailties of the Third Circuit test, such an approach runs afoul of the liberal creativity standard of *Feist*, which mandates protection of original expression, except where “the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Feist* at 359 (1991). Thus, for a fourth time the Third Circuit rule went against well-established law, further deteriorating the fairness inquiry.

The inadequacy of the Third Circuit position is explained by a body of law that lacks unity and coherence.

The current circuit split appears to have evolved as an unintended result of a body of precedent where different things are called by the same name, the same things are called by different names, and different elements and their proofs have been conflated into impossible and nonsensical combinations.

The remedial action of this Court is sorely needed.

The decision of the District Court highlights the egregiousness of the rules in the Third and Ninth Circuits.

The treatment of the highly original plot of the book written by Ms. Nicassio at the Third Circuit demonstrates the frailty of the view it shares with the Ninth Circuit. In an irrelevant attempt to discredit the plaintiff's position in the District Court, the Defendant sought to show that the plot of a Christmas tree dreaming of becoming the Rockefeller Center Christmas tree was old, and introduced what were apparently the results of a search for evidence supporting such a showing. Rather than supporting the proposition, the search only uncovered a poem about Christmas ornaments dreaming of being on a tree, a tree that became a Christmas tree, and a Christmas tree that became firewood. App. 55a-56a. Defendant Publishers' failed search proved that

there was no generic plotline, and demonstrated the highly original nature of Ms. Nicassio's general plot (App. 52a-54a).

Returning to the application of the Ninth Circuit rule, and with the proven creativity of "Rocky" as a backdrop, "Albert" copied the same original and creative overall story, together with the plot elements, in substantially the same order, of a little tree in a plant and human community (a forest in "Rocky" and a plant nursery in "Albert") dreaming of becoming the Rockefeller Center tree, the same being unlikely because Rocky and Albert were small, Rocky and Albert being mocked by community members for their dreams and becoming discouraged, but Rocky and Albert being encouraged by the words of a mentor (a fairy in "Rocky" and a little girl in "Albert"), a group of other members of the community organizing to stop Rocky and Albert from achieving the dream and launching an attack using plant parts (a snare of twigs in "Rocky" and cactus needles in "Albert"), selection of a "special" tree being done by judges in a red bubble helicopter, similar exclamations from the judges upon discovery of the winning tree, Rocky and Albert getting to New York on the helicopter (Rocky as the primary passenger, Albert as a hitchhiker), Rocky and Albert being crowned at Rockefeller Center (Rocky as the original winner of the competition, Albert as a substitute top for the Judges' selection), "to become the most famous Christmas tree in the world," and with Rocky and Albert then recalling verbatim the words of

encouragement from the mentor. See also App. 32a-34a.

The Ninth Circuit approach resulted in a comparison of the least important elements in the original and accused works, graphically illustrating the Second Circuit’s criticism of the approach as “mechanical and counterintuitive.” *Knitwaves* at 1003.

In a series of steps, the District Court proceeded to eliminate the entire central plot of Ms. Nicassio’s book as “too generic.” App 35a. In a majority rule circuit, the plot would easily have been found protectable as exceeding the “creative spark... utterly lacking or so trivial as to be virtually nonexistent” threshold. Respectfully, this aspect of the Third Circuit decision appears to be a clear violation of this Court’s precedent. *Feist* at 359.

Next, the plotline and the things which naturally flowed from it were removed from both works under the Ninth Circuit rule, and the remaining peripheral and disjointed parts of the stories, including material added in the copied work, were compared in the wrongful appropriation assessment. App. 9a-10a.

The District Court’s “comparison” of the works then boiled down to noting that “Albert” dealt with an additional attack from his nemesis, that there was another attack from vegetarian bunnies, that Albert travelled to New York as a hitchhiker whereas Rocky was the intended passenger, that Albert was crowned as the top tree portion supported by the bottom portion of another tree, and then after

being crowned gave his rival a chance to share the spotlight. App. 37a-38a.

Having removed the heart of the work, the comparison became meaningless, and the District Court was forced to accept the Defendants' contention that despite "sharing the same basic story," "Rocky" and "Albert" are not similar (App. 34a-35a), not considering the central elements of the plot and relying instead on elements added into in the alleged work "e.g., the importance of family, empathy, and forgiveness." App. 37a.

In a majority rule jurisdiction, the opposite result would have occurred. More particularly, 1) the creativity and originality of the story, evidenced on the record by the search results disclosed by the Defendant, would at least have created a question of fact as to whether the "shar[ed] ... basic story" was protectable expression. If that were not enough to defeat dismissal, 2) the conceded copyist's identical sequence of identical and equivalent plot elements would have militated against dismissal, not to mention 3) the effect of the majority *scènes-à-faire* rule that would have placed significant portions of Nicassio's original expression into the comparison (as mandated by this Court (*Harper* at 547)). The majority rule would have further protected the author's rights by 4) removing the distraction of material added in "Albert" from the comparison, following Second Circuit law endorsed by this Court. *Harper* at 565.

**III. This case is of substantial importance
and presents an ideal vehicle for resolving
the questions presented.**

The rule in the Ninth Circuit is a recipe for movie producers to unfairly evade liability, despite cooking up a work which, to use Judge Hand's words in *Sheldon*, has "most effectively pirated [the original] by leaving out the speech, for which a substitute [has been] found, which [kept] the whole dramatic meaning." (Bracketed material added) *Sheldon* at 56.

Under the rule at issue here, before doing the wrongful taking comparison of the two works to measure unfairness in the view of the intended reader, a simplified version of the plot is declared "too generic" and removed from consideration. There is no need for such an unanchored critical assessment of the creativity of the author, given universally accepted law that a generic plot cannot be protected. This fairly leaves the matter to be decided on the basis of evidence of the generic category, or absent that by a fairness determination.

Removing everything that naturally flows from the same leaves only peripheral plot elements of the two stories to compare. Comparing the resulting phantom original and phantom copy works (which never were and never will be seen by anyone) to assess the "fairness" of the taking is illogical.

The result is to facilitate a travesty committed by the massive publishing and entertainment industry against the creative community that forms its own lifeblood. Such unfairness should hardly be tolerated

in such an important sector of the economy. Indeed, U.S. movie producers alone had gross revenues for 2017 reported at \$43.4 billion.²

CONCLUSION

This Petition presents an opportunity for a long overdue comprehensive resolution of a confusing and contradictory body of appellate decisions.

All aspects of the frailty of the Ninth Circuit rule, and their relationship to each other, are implicated in the questions presented. The District Court's unanchored determination of the plot was "too" simple to be protected puts a court in the position of being an arbiter of cultural merit. Calling a simplified plotline of its own creation "too generic" (meaning too simple) and unworthy of consideration, besides violating the low level of creativity standard of *Feist*, carries the danger, in many cases, of excluding a creative spark of genius that may give a work its expressive power. This is clearly unfair and illogical.

Likewise, the Ninth Circuit's breathtakingly broad definition of *scènes-à-faire* to include all things

² *Deadline*, July 13, 2018, available at <https://deadline.com/2018/07/film-industry-revenue-2017-ibisworld-report-gloomy-box-office-1202425692/>

which naturally flow from the simple plot is at issue here. The Ninth Circuit's dissection of the author's original expression from the wrongful appropriation inquiry is also at issue in this case. Finally, the propriety of considering *scènes-à-faire* in the fairness assessment is implicated in the decision of the Court of Appeals.

The two questions presented require the Court to answer purely legal questions. The dissection question has split the Circuits for about forty years and the dramatic difference in scope in defining *scènes-à-faire* has existed for about thirty years. Despite the fundamentally outcome determinative nature of the conflict, no uniform copyright infringement test has emerged.

The petition for a writ of certiorari should be granted.

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